

**REMARKS/ARGUMENTS****Rejection Under 35 U.S.C. §103**

Claims 1 and 3-7 were rejected under 35 U.S.C. 103(a) as being unpatentable over Buck in view of Robson, newly cited Nanba, newly cited Kubota and newly cited Chang.

Applicants have amended claim 1. Support for such amendment may be found on page 1, lines 9-16. There was no motivation or suggestion to combine the cited references to reach the presently claimed invention.

First, Nanba does not disclose the disruption of *mycobacterial*, yeast or fungi cells. Rather, column 9, lines 62-65 disclosed an experiment wherein *E.coli* cells were disrupted. As discussed in the application, mycobacterial, yeast and fungi cells are particularly difficult to disrupt.

Second, a *prima facie* case of obviousness cannot be established by combining prior art references unless there is some suggestion, motivation or incentive in the prior art to make the proposed modification. *ACS Hospital Systems, Inc. v. Montifiore Hospital*, 221 USPQ 929, 932-33 (Fed. Cir. 1984). Failure of the Examiner and/or Board to provide the necessary suggestion or motivation will create a presumption that the combination of references selected by the Examiner to support the obviousness rejection was based on hindsight. See *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). In fact, the cited references teach away from the present invention: the Board of Appeals held in its May 30, 2003 Decision that cited reference "Robson, directs a person of ordinary skill in the art away from sonication methods and toward a method of heat lysis of *Mycobacterial tuberculosis*." (page 8)

Accordingly, Applicants submit that the rejection should be withdrawn.

**Rejection Under 35 U.S.C. §102**

Claim 8 was rejected under 35 U.S.C. §102(e) as being anticipated by Kubota in light of Chang.

Claim 8 depends from currently amended claim 1. Claim 1 recites a second liquid at an alkaline pH. Kubota, however, does not teach a second liquid at an alkaline pH. Since Kubota

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does not disclose each element of claim 8, Applicants respectfully request withdrawal of the rejection.

**Rejection Under 35 U.S.C. §103**

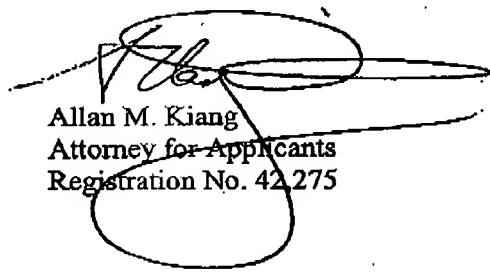
Claims 8-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Buck in view of Kubota, Chang, Robson and Nanba.

Applicants have amended claim 1, from which claims 8-13 depend. For the reasons stated above, Nanba does not disclose the disruption of *mycobacterial*, fungi or yeast cells. Furthermore, there was no motivation or suggestion to combine the other cited references. Accordingly, Applicants request withdrawal of the rejection.

**Conclusion**

The claims of the present application are believed to be in condition for allowance and early notice thereof is respectfully requested.

Respectfully submitted,



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